



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/625,340

Confirmation No. : 8601

Inventor : Gerald K. Hein

Filed : 07/22/2003

TC/A.U. : 3753

Examiner : CIRIC, Ljiljana V.

Title : A SYSTEM FOR RELIABLY REMOVING HEAT FROM A
SEMICONDUCTOR JUNCTION

Docket No. : 1444-0096

RESPONSE TO OFFICE ACTION AND ELECTION/RESTRICTION

To: Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action mailed September 22, 2006 in the above-identified application, Applicant elects Invention I and claims 1-14 with traverse. Applicant respectfully submits that the Inventions as differentiated in the Office Action are not independent or patentably distinct.

In particular, Applicant submits that the Examiner has neither established that: (1) the apparatus as claimed can be used to practice another and materially different process, nor (2) the process as claimed can be practiced by another and materially different apparatus, or by hand.

As to (1), the first material difference cited is maintaining the heat sink member in direct engagement with both the integrated circuit board assembly and a mounting member. It is improper that “maintaining” can be found to be materially different from “directly engaging...to establish a low thermal resistance path from the integrated circuit to the mounting member, permitting heat to be removed from the integrated circuit” (claim 21). Maintaining requires some amount of time, as does permitting heat to be removed.

The second material difference cited is “the heat sink member is received by the attachment member”. As claimed, “...the heat sink member engages said mounting member via an attachment member.” It is improper, both on its face and in light of the specification, that “is received” is materially different from “engages”.

As to (2), the material difference cited is “...the apparatus...includes an attachment member which is not necessarily positioned on the mounting member.” However, the apparatus as described in the Office Action is probably not usable in the claimed process. The last element of the process in claim 21 states “disengaging the heat sink member from the mounting member without disengaging the attachment member from the mounting member.” Accordingly, the step of “without disengaging the attachment member from the mounting member” cannot be practiced on an apparatus where the attachment member is not even positioned on the mounting member.

Further, there is no additional burden if there is no restriction. Serious burden (MPEP 808.02) exists if any of the following are met: (a) separate classification, (b) separate status in the art, or (c) a different field of search.

As to (a), there is not a "separate" classification in the instant case. Invention 1, as classified by the Office Action, is in a sub-class of Invention 2. The word "separate" means set or kept apart, not shared with another, autonomous, and/or existing by itself, etc. Accordingly, the classification of Invention 1 cannot be separate if it is a part of the classification of Invention 2.

As to (b), it must be shown that each invention has formed a separate subject for the inventive effort by showing a recognition of separate inventive effort by inventors. This have not been shown in the instant case.

As to (c), it is unlikely that a search for Invention 1 would not yield the same art for Invention 2. This is again because the classification for Invention 1 is a sub-set of the classification of Invention 2.

Accordingly, applicant respectfully submits that the Office Action does not satisfactorily establish a restriction requirement.

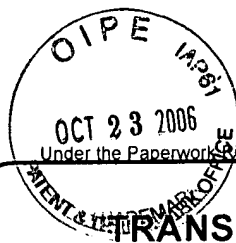
Respectfully submitted,

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/625,340	
	Filing Date	07/22/2003	
	First Named Inventor	HEIN, GERALD K.	
	Art Unit	3753	
	Examiner Name	CIRIC, Ljiljana V.	
Total Number of Pages in This Submission	5	Attorney Docket Number	1444-0096

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Cook, Alex, McFarron, Manzo, Cummings & Mehler, Ltd.		
Signature			
Printed name	David M. Mundt		
Date	October 23, 2006	Reg. No.	41,207

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